

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated December 30, 2008, (hereinafter Office Action) have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Although claim amendments are presented, none of the amendments introduces new matter or should require additional search or examination. For example, the changes to Claims 6, 7, 14, 18, 21-23, and 29-31 merely replace acronyms with their corresponding terms and/or change the capitalization of a term. Further, changes to Claims 14 and 15 merely provide consistency with the preamble of the underlying independent claim. In addition, the changes to Claims 13, 16, 19, and 26 merely clarify that the tunneling address is sent from another access device, as is already claimed in Claim 1. Thus, none of these changes is believed to introduce new matter or affect the scope of the claims, and none are made for reasons related to the asserted references.

Applicant respectfully traverses each of the prior art rejections, each of which is based upon the teachings of U.S. Patent No. 6,654,359 to La Porta *et al.* (hereinafter “La Porta”), because La Porta does not teach or suggest each of the claimed limitations. Specifically, La Porta does not at least teach transferring the tunneling IP address from the first access device (from which the terminal is being handed over from) to a second access device, as claimed in each of the independent claims. The cited portion at column ten merely states that a handoff path setup message is transmitted in case of handoff between base stations in a current domain. However, La Porta explicitly describes at Col. 21, lines 45-47 (emphasis added), “The mobile device 114 then transmits the handoff path setup message over a first hop 450 to base station BS10 IntfB.” It is further explained that IP packet routing information is updated on the basis of this message, and then the ‘new base station’ BS10 forwards the handoff path setup message to the ‘old base station’ BS9 (Fig. 15) or the handoff path setup message is transferred to the old base station BS9 via a router (Fig. 14). The old base station (from which the mobile device is being handed over from) merely transmits an acknowledgement. Thus, La Porta does not teach that a tunneling

address is transferred from an ‘old access device’ to a ‘new access device’, as claimed. Rather, in La Porta the asserted base station merely acts as a router, *see, e.g.*, Col. 21, lines 50-54 and Col. 22, lines 35-36. Since La Porta fails to teach transferring the tunneling IP address as claimed, La Porta also fails to correspond to the limitations directed to a second access device based on the tunneling IP address received from the first access device. Without correspondence to each of the claimed limitations, the prior art rejections are improper.

In addition, the base station of La Porta is not disclosed as having any tunneling related functionality, as claimed. The reference to tunneling at column ten refers to a home agent HA that tunnels data between a home domain and a foreign domain on the basis of mapping between a local address (care-of address in the foreign domain) and home address in the home domain. *See, also*, Col. 5, lines 18-21. While the local IP address is used in the foreign domain to identify a mobile device and to route packets from the HA to the device, this is performed via normal IP routing. The base stations do not have any tunneling functionality related thereto. Thus, the asserted access devices of La Porta do not correspond to the claimed first and second access devices.

With particular respect to the § 102(e) rejection, in order to anticipate a claim the asserted reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit also recently held that “Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” (*Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 2008 (Fed. Cir. 2008) quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Applicant respectfully maintains that La Porta does not teach every element of independent Claims 1, 13, 16, 19, and 26 in the requisite detail, and

therefore fails to anticipate Claims 1, 2, 8, 13, 15-17, 19, 20, 24-28 and 32. Accordingly, Applicant requests that the rejection be withdrawn.

Dependent Claims 2, 8, 15, 17, 20, 24, 25, 27, 28 and 32 depend from independent Claims 1, 13, 16, 19, and 26, respectively, and also stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by La Porta. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are also improper for the reasons discussed above in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited reference. Therefore, the rejection of dependent Claims 2, 8, 15, 17, 20, 24, 25, 27, 28 and 32 is improper, and Applicant requests that the rejection be withdrawn.

With particular respect to the § 103(a) rejection of dependent Claims 6, 7, 14, 18, 21-23, and 29-31, Applicant traverses because the further relied-upon teachings of Johansson fail to overcome the above-discussed deficiencies in the teachings of La Porta. For example, Johansson has not been shown to teach or suggest transferring a tunneling IP address from a first access device (from which the terminal is being handed over from) to a second access device. Further, with respect to the rejection of Claims 7, 14, 18, 21, 23, 29, and 31, the Office Action fails to assert any rationale for combining the alleged teachings of Johansson with those of La Porta. The mere assertion that Johansson may teach the claimed limitations fails to provide the requisite support for a § 103(a) rejection. Since the asserted teachings have not been shown to correspond to each of the claimed limitations, and no rationale for combining certain of the teachings has been presented, the § 103(a) rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.047PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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